

Serial No. **09/837,291**

Docket No. **P-0204**

Amendment dated July 6, 2006

Reply to Office Action of April 7, 2006

### **REMARKS**

Entry of the amended claims is proper under 37 C.F.R. §1.116 since the amendments: (1) place the application in condition for allowance (for the reasons discussed herein); (2) do not raise any new issues requiring further search and/or consideration (since the amendments amplify issues previously discussed throughout prosecution without incorporating additional subject matter); (3) satisfy a requirement of form asserted in the previous Office Action; and/or (4) place the application in better form for appeal (if necessary). Entry is thus requested.

By the present response, Applicant has amended claims 1 and 16 to further clarify the invention. Claims 1, 3-29 and 34 are pending in this application.

In the Office Action, claims 20-26, 28-29 and 34 have been rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. 2003/0014318 (De La Motte et al.). Claims 1 and 3-19 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over the Applicants' disclosure. Claim 27 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over De La Motte et al.

### **Response to Arguments**

The Examiner indicates that Applicants' arguments filed January 10, 2006 have been fully considered but are not persuasive. Regarding the rejection of claims 1 and 3-19, the Examiner bases his support for these rejections on the mere statement in Applicants' background of the invention that purchasing technology has been applied to the Internet. From this simple

statement the Examiner then uses impermissible hindsight in asserting that the limitations in these claims is "old and well known in the art", and that Applicant is "broadly automating a known method utilizing a known and existing technology". Applicant submits that the Examiner uses impermissible hindsight in reading the limitations of Applicants' claims back into the cited prior art. The Examiner provides no references that support his "well known in the art" assertions, and provides no appropriate motivation for one of ordinary skill in the art to combine the disclosure in Applicants' background of the invention with the concepts of the Internet and specifically the concepts as recite the claims of the present application.

Applicants assert that the Examiner has used impermissible hindsight in making the rejections. The Federal Circuit has forbidden the use of hindsight in the selection of references that comprise the case of obviousness. See, In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). Moreover, as the Federal Circuit has stated in In re Rouffet, 47 USPQ2d 1453 (Fed. Cir. 1998) at pages 1457 and 1458:

As this court has stated, "virtually all [inventions] are combinations of old elements." Environmental Designs, Ltd. v. Union Oil Co., 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); see also Richdel, Inc. v. Sunspool Corp., 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an

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illogical and inappropriate process by which to determine patentability." Sensonics, Inc. v. Aerosonic Corp., 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996).

To prevent the use of hindsight based on the invention to defeat patentability of the invention, the court has required the Examiner to show a motivation to combine the references that create the case of obviousness. In other words, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

Applicants respectfully submit that the Office Action relies on impermissible hindsight as there is no suggestion in the prior art for the features and/or combinations. That is, it is well-founded that when a rejection depends on a combination of prior art references, there must be some teachings, suggestion, or motivation to combine the references. See ACH Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984) and In re Geiger, 815 F.2d, 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987). Applicants believe that there is no teaching, suggestion, or motivation to combine the references (here just Applicants' background and the Internet generally) and the rejection of all the claims should be withdrawn at least for this reason. There is no suggestion in the references to make the combination. Rather, the only motivation is provided in Applicants' own specification. The Office Action can not use Applicants' own specification as a "road map" to find the claimed

features. As stated in In re Gorman, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991), the references themselves must provide some teaching whereby the Applicants' combination would have been obvious. The Office Action therefore relies on impermissible hindsight. The applied references do not contain any teaching whereby the claimed features would have been obvious. Additionally, the Office Action clearly relies on a piecemeal reconstruction of the prior art in order to find claimed features. In view of this, the combination and rejections are improper and should be withdrawn.

Moreover, the Examiner appears to believe that an invention providing an advantage of increased speed and efficiency is not a patentable invention, and also states that the Applicant is not claiming specific features or structures that make the automation possible. Applicants respectfully disagree with these statements. The claims in the present invention clearly recited at least one server that performs the various automatic purchasing functions of Applicants' claimed invention. Further, the Examiner ignores the details of structure recited in claim 8 directed toward a purchasing system which recites a web server, an internal database, and an external database as well as claim 13 that recites a plurality of region terminals, a plurality of region servers, and a main server. The Examiner provides no prior art references that disclose or suggest these limitations in the claims of the present application, and further provides no motivation for one of ordinary skill in the art to combine these structures with Applicants' background of the invention. Applicants respectfully request that the Examiner provide

references that support his assertions that the limitations in the claims of the present application are “well known” as well as appropriate motivation to combine any asserted references in an attempt to achieve the limitations in the claims of the present application.

Regarding the rejections of claims 20, 26 and 34, in response to Applicants’ argument that DE does not disclose or suggest identifying whether vendors satisfy minimum attributes set by a buyer, the Examiner states that “DE discloses that the structure and dynamics of the market to both buyers and suppliers are such the need for intermediaries are eliminated. However, since buyers and suppliers may continue to require the services provided by third-parties, the system 100 provides a transactional link through which the services can be retained.” Applicant submits that this has nothing to do with vendors satisfying minimum attributes set by a buyer, as recited in the claims of the present application. Further, the Examiner goes on to state that “it is exceedingly clear that DE did not mention in the slightest in col. 2, lines 1-4, products and factories of suppliers being evaluated by an independent organization, contrary to the Applicants assertion in the remarks.” Applicants fail to understand this statement by the Examiner in that clearly DE discloses starting at col. 1 in paragraph 12 extending to col. 2, that “both the **products and factories of suppliers are evaluated by an independent, quality-control measurement organization**, which applies ratings to the products and factories in accordance with the standardized rating system.” Applicant does not understand the Examiner’s comments when the words mentioned by Applicants are the exact words stated in the reference.

The Examiner further asserts that DE discloses identifying vendors satisfying minimum attributes set by a buyer, by DE's remote buyers developing RFQs describing details of the products that they offer. However, attributes of a product are not satisfying minimum attributes of a vendor set by a buyer.

The Examiner further maintains that DE discloses registering vendors that satisfy minimum attributes. However, the Examiner does not address Applicants' remarks and merely continues to state that each buyer, supplier, and third party service provider gains access or membership to the system by registering with the system. As noted in Applicants' previous response, every buyer, supplier, and third-party service provider gains access or membership to the system by registering. This is not registering vendors that satisfy minimum attributes, as recited in the claims of the present application.

Moreover, the Examiner maintains that DE discloses identifying whether vendors satisfy minimum attributes set by a buyer, but as noted in Applicants' previously filed response, that the Examiner does not respond to, DE does not disclose to automatically select a qualified vendor to the buyer based on the database information and the selection criteria collected from the buyer, as recited in the claims of the present application. The software filters disclosed in DE do not disclose or suggest these limitations in the claims of the present application.

35. U.S.C. §102 Rejections

Claims 20-26, 28, 29 and 34 have been rejected under 35 U.S.C. §102(e) as being anticipated by DE. Applicants respectfully traverse these rejections.

Regarding claims 20, 26, 20 and 34, Applicants submit that DE does not disclose or suggest the limitations in the combination in each of these claims. For example, the Examiner asserts that DE discloses identifying whether vendors satisfy minimum attributes, in the abstract and paragraphs 31-32. However, this is not identifying other vendors satisfying minimum attributes set by a buyer, as recited in the claims of the present application. In contrast, DE discloses products and factories of suppliers being evaluated by an independent organization (see, column 2, lines 1-4).

Further, the Examiner asserts that DE discloses registering the vendors that satisfy the minimum attributes, at paragraphs 29 and 30. However, these paragraphs merely disclose that each buyer, supplier and third-party service provider gains access or membership to the system by registering with the system operator, and that registered companies may designate multiple employees or agents as authorized buyers for the company. This is not registering the vendors that satisfy the minimum attributes, as recited in the claims of the present application. These portions of DE disclose that each buyer, supplier, and third-party service provider gains access to the system. These portions do not disclose or suggest anything related to registering vendors that satisfy minimum attributes.

The Examiner further asserts that DE discloses identifying the buyer's vendor selection criteria, by the disclosure of RFQs in paragraphs 13 and 14. However, request for quotes (RFQs) as disclosed in DE are not a buyer's vendor selection criteria, as is cited in the claims of the present application. According to the present invention, a buyer's vendor selection criteria includes information used by the buyer in the selection of a vendor, for example, geographic region, business type, price, etc. (see, claim 21). A buyer's vendor selection criteria is not an RFQ (that specifies objective and subjective aspects of a product) as disclosed in DE.

The Examiner further asserts that DE discloses an engine to select a qualified vendor for the buyer based on the database information and the selection criteria, in paragraphs 32 and 33. However, these portions merely disclose that buyers can activate software filters to screen offers from suppliers based on product type, on supplier, country of origin, etc. This is not an engine to automatically select a qualified vendor for the buyer based on the database information and the selection criteria, collected from the buyer, as recited in the claims of the present application. According to the present invention, a qualified vendor is automatically selected for the buyer.

Regarding claims 21-25, 28 and 29, Applicants submit that these claims are dependent on one of independent claims 20 and 26 and, therefore, are patentable at least for the same reasons noted previously regarding these independent claims.

Accordingly, Applicants submit that DE does not disclose or suggest the limitations in the combination of each of claims 20-26, 28, 29 and 34 of the present application. Applicants



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respectfully request that these rejections be withdrawn and that these claims be allowed.

35 U.S.C. §103 Rejections

Claims 1-19 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Applicants' disclosure. Applicants respectfully traverse these rejections and submit that these claims are patentable for the reasons discussed previously in the Response to Arguments section of this response. As noted previously, the Examiner ignores the details of structure recited in the claims of the present application, e.g., a web server, an internal database, an external database, a plurality of region terminals, a plurality of region servers, a main server, etc. Moreover, the Examiner provides no prior art references that disclose or suggest these limitations in the claims of the present application, and further provides no motivation for one of ordinary skill in the art to combine these structures with Applicants' background of the invention. Applicants respectfully request that the Examiner provide references that support his assertions that the limitations in the claims of the present application are "well known" as well as appropriate motivation to combine any asserted references in an attempt to achieve the limitations in the claims of the present application. The Examiner's rejections are improper under 35 U.S.C. §103 due to this failure to provide the required support and motivation.

Accordingly, Applicants submit that claims 1-19 are patentable over Applicants' background of the invention. Applicants respectfully request that these rejections be withdrawn and that these claims be allowed.

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Claim 27 has been rejected under 35 U.S.C. §103(a) as being unpatentable over DE. Applicants submit that this claim is dependent on independent claim 26 and, therefore, is patentable at least for the same reasons as noted previously regarding this independent claim. Accordingly, Applicants submit that DE does not disclose, suggest or render obvious the limitations in the combination of claim 27 of the present application. Applicants respectfully request that this rejection be withdrawn and that this claim be allowed.

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**CONCLUSION**

In view of the foregoing amendments and remarks, claims 1 and 3-29 and 34 are now in condition for allowance. Accordingly, early allowance of such claims is respectfully requested. If the Examiner believes that any additional changes would place the application in better condition for allowance, the Examiner is invited to contact the undersigned attorney, Frederick D. Bailey, at the telephone number listed below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this, concurrent and future replies, including extension of time fees, to Deposit Account 16-0607 and please credit any excess fees to such deposit account.

Respectfully submitted,  
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